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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,079	03/26/2001	Michael S. Terretta	267665.0021	9836

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EXAMINER

HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/817,079

Applicant(s)

TERRETTA, MICHAEL S.

Examiner

Calvin L Hewitt II

Art Unit

3621

MLW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 1-20 have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 9 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The Applicant discloses LDAP databases and providers of caching technology for use with LDAP databases, however the Specification is silent regarding exclusively caching registration information in the RAM of an LDAP database.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 is silent regarding how the system is to perform if the user is **not** "currently receiving restricted content" hence; one of ordinary skill is hindered from determining how to use Applicant's system and the scope of said system.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3, 4, 6, 17, 19, and 20 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kenner et al., U.S. Patent No. 5,956,716.

As per claims 1, 3, 4, 6, 17, 19, and 20, Kenner et al. teach a system for processing user registration information comprising: a commerce server and a database for requesting, receiving and storing registration information (e.g. name, address, media player, payment method, max. charge- "mode of payment", password, media format, e-mail), and the user providing the

registration information by completing a registration form (figure 4; column 20, lines 10-49; column/line 21/18-22/60; column 33, lines 34-44). Kenner et al. also teach using registration information stored in a database to that controls user access to restricted information, and verifying said user's access to said restricted content before transmitting said restricted content to said user (column/line 21/19-22/16; column 24, lines 15-58; column 26, lines 33-40; column/line 33/47-34/28; column 34, lines 40-61), and verifying a proposed payment mode provided by said user in connection with receiving said registration information from said user (column/line 21/19-22/16; column/line 33/34-34/28).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2, 5, 7-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenner et al., U.S. Patent No. 5,956,716 in view of Hartman et al., U.S. Patent No. 5,960,411.

As per claims 2 and 11, Kenner et al. do not specifically recite utilizing a redundant array of servers. However, it has been held that to one of ordinary skill, it would have been obvious to duplicate a part for a multiple effect (In re Japikse), such as to increase the capacity of the system of Kenner et al. by utilizing multiple servers.

As per claim 5, Kenner et al. teach payment methods, pay-per-view and storing user credit card numbers in a database (column/line 33/34-34/28). Therefore, to one of ordinary skill it would have been obvious to expedite the financial verification process by linking the PIM of Kenner et al. (figure 4) to a financial network for determining whether a user is eligible to receive content

As per claims 7-9 and 12-14, Kenner et al. also do not specifically recite an LDAP database. However, the use of LDAP and SQL databases are old and well-known. Kenner et al. teach obtaining payment information such as a payment method and credit card number (column 22, lines 5-8; column 33, lines 38-44).

As per claims 10, 15, 16, and 18, Kenner et al. teach a media server for delivering content and a web server, in connection with the media server, that queries a database (comprising registration information) for determining whether a user can receive restricted content (figure 4; column/line 8/51-9/14; column/line 21/45-22/10; column 24, lines 15-58; column 34, lines 29-62). The web server also has access to identifier data for determining which media server is delivering

content (abstract; column 22, lines 46-62) as the web server, before permitting downloading content to a user, the web server determines whether the content is "local" to a user, and if not finds a "closest" server that stores said content (abstract). Hence, the web server has access to data regarding whether a user is *currently delivering restricted content to a user*. Further, the web server uses this data for determining the frequency with which a media server file is requested (column 30, lines 1-22). However, the limitation regarding *currently delivering restricted content to a user* is non-functional data as descriptive material cannot render nonobvious an invention that would have otherwise been obvious (*In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability)). Specifically, the MPEP (2106 section V, B, 2) states that a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer). In claim 16, the limitation is functional as the Applicant's system uses the data of whether the user is *currently receiving restricted content from a media server* to determine if a user should receive said content. However, claim 16 recites conditional language and the MPEP states that "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular

structure does not limit the scope of a claim or claim limitation.” (MPEP, 2106 section II, C). Hence, for purposes of examination, the Examiner is considering the case where the user is **not** currently receiving content, in which case the system merely provides the user with the content (abstract; column/line 33/33-34/61). Nonetheless, this feature of determining whether or not a user is eligible to receive content based on “if said potential user is currently receiving restricted content” is well known. Specifically, the term, to one of ordinary skill in sales, is “limited to one per customer”. Further, in light of the teachings of Kenner et al. it would have been obvious to implement such a sales strategy to prevent bottlenecks due to the popularity of a file, or denial of service attacks.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:
 - Wiser et al. teach a secure system for online content distribution
 - Hartman et al. teach user registration
 - Nagel et al. disclose user registration for receiving content
11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone

number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

(703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Calvin Loyd Hewitt II

June 13, 2004



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600